<div align="center">**REMARKS**</div>

I.   **Introduction**

Claims 1-24 are pending in the application. In the Office Action dated Oct. 20, 2008, the Examiner rejected claims 22-24 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 7,028,082 ("Rosenberg"). Additionally, claims 1-3, 5-14, 16, 17, and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of U.S. Pat. No. 7,272,629 ("Yamaura"), and claims 4, 15, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Yamaura and U.S. Pat. No. 6,643,621 ("Dodrill"). Applicants request reconsideration in light of the following remarks.

II.   **The Proposed Combinations Do Not Render Claim 1 Unpatentable**

A.   **The Proposed Combination of Rosenberg and Yamaura Is Improper**

Amended independent claim 1 generally recites a first client apparatus including an uploading unit operable to allow a user to transmit data from a desired medium of the user to a server apparatus; a list presenting unit operable to present a list of music on a second client apparatus to the user that are available to be transmitted to the second client apparatus, wherein the presented music data is music data uploaded in advance onto the server apparatus by the user; and a server data transmitting/receiving unit operable to transmit desired music data of the list of music data to the second client apparatus of the user in response to a selection by the user at the second client apparatus of the desired music data of the list of music data available to be transmitted to the second client apparatus. The Examiner has acknowledged that Rosenberg fails to teach transmitting music data in response to selection of the music data by a user. In an attempt to cure the deficiency, the Examiner proposes combining Rosenberg with Yamaura.

Applicants maintain that modifying Rosenberg as proposed by the Examiner to perform actions such as transmitting music data in response to selection of music data by a user alters a principle operation of Rosenberg. Applicants additionally maintain that Rosenberg teaches away from the combination of Rosenberg and Yamaura. For at

least these reasons, the combination of Rosenberg and Yamaura as contemplated by the Examiner is improper.

Rosenberg is directed to a personalized audio system and method. Generally, Rosenberg teaches users creating a profile with information regarding music preferences. The music preferences may relate to a specific type of music, or specific songs. The profiles with music preferences are submitted to broadcasters that create playlists for audio channels based on the music preferences of users who listen to the audio channels. Rosenberg specifically states that a user has no direct control over which songs get played on an audio channel. (See Col. 8, lines 5-23). Accordingly, altering Rosenberg to transmit music data in response to selection of music data by a user rather than broadcasters broadcasting music based on music preferences submitted by users alters a principle operation of Rosenberg.

In the Office Action, the Examiner asserts that there is no reason why one ordinary skill in the art would not be able to combine the music or audio list presenting system of Rosenberg to content supplying servers and transmitting desired music data of a list of music data in response to selection of the music data by a user as taught in Yamura. (See Office Action dated Oct. 20, 2008, page 3). Applicants have not argued that Rosenberg would be rendered inoperable by the combination of Rosenberg and Yamura as contemplated by the Examiner, but have argued that the proposed combination alters a basic principle under which Rosenberg was designed to operate. As discussed in MPEP § 2143.01(Vi.), "[i]f the proposed combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facia* obvious." Applicants respectfully submit that whether or not it is possible to modify Rosenberg as contemplated by the Examiner does not address whether the proposed combination alters a principle operation of Rosenberg.

Further, Applicants maintain that because Rosenberg specifically states that a user has no direct control over which songs get played on an audio channel, Rosenberg teaches away from the combination of Rosenberg and Yamura as contemplated by the Examiner. It is improper to combine references when the references teach away from their combination. See MPEP §§ 2141.02 and 2145. Applicants note that the Examiner

did not address the position of the Applicants that Rosenberg teaches away from the proposed combination in the Office Action dated Oct. 20, 2008.

Because modifying Rosenberg as proposed by the Examiner to perform actions such as transmitting music data in response to selection of music data by a user alters a principle operation of Rosenberg, and because Rosenberg teaches away from the combination of Rosenberg and Yamaura as contemplated by the Examiner, the proposed combination of Rosenberg and Yamaura is improper. Accordingly, the proposed combinations of Rosenberg, Yamaura, and Dodrill do not render independent claim 1, or any claim that depends on claim 1, unpatentable.

B.   The Proposed Combination of Rosenberg and Yamaura Does Not Teach Each Element of Amended Claim 1

Amended independent claim 1 generally recites a first client apparatus including an uploading unit operable to allow a user to transmit data from a desired medium of the user to a server apparatus; a list presenting unit operable to present a list of music on a second client apparatus to the user that are available to be transmitted to the second client apparatus, wherein the presented music data is music data uploaded in advance onto the server apparatus by the user; and a server data transmitting/receiving unit operable to transmit desired music data of the list of music data to the second client apparatus of the user in response to a selection by the user at the second client apparatus of the desired music data of the list of music data available to be transmitted to the second client apparatus. In the proposed combination of Rosenberg and Yamaura, the Examiner asserts that Rosenberg teaches each element of claim 1 except transmitting desired music data of a list of music data in response to selection of the music data by a user, which the Examiner asserts is taught in Yamaura.

As discussed above, Rosenberg generally teaches users creating a profile with information regarding music preferences. The music preferences may relate to a specific type of music, or specific songs. The profiles with music preferences are submitted to broadcasters that create playlists for audio channels based on the music preferences of users who listen to the audio channels. Rosenberg fails to teach a system that provides a first client apparatus that allows a user to transmit music data to a server apparatus, a second client apparatus that allows the user to select the music

data that has been previously uploaded to the server apparatus by the user, and a server transmitting/receiving unit operable to transmit the selected music data to the second client apparatus as in amended claim 1. Further, Applicants maintain that Rosenberg teaches broadcasters *broadcasting* songs rather than a system where content is *transmitted* as in amended claim 1.

For at least these reasons, the proposed combinations of Rosenberg, Yamaura, and Dodrill do not render amended independent claim 1, or any claim that depends on claim 1, unpatentable.

III.   The Proposed Combinations Do Not Render Claim 13 Unpatentable

Amended independent claim 13 generally recites a selecting unit operable for a user to select desired music data from a list of music data presented by a server apparatus, where the music data presented by the server apparatus is music data uploaded on the server apparatus by the user, and a reproducing unit operable to receive data corresponding to the music data selected by the user at the selecting unit that has been transmitted from the server apparatus in response to selection of the music data by the user, and apply decoding corresponding to a medium.

In the proposed combination of Rosenberg and Yamaura, the Examiner asserts that Rosenberg teaches each element of claim 13 except transmitting desired music data of a list of music data in response to selection of the music data by a user, which the Examiner asserts is taught in Yamaura. Rosenberg fails to teach a system that provides a selecting unit operable for a user to selected desired music from a list of music data presented by a server apparatus that was previously uploaded to the server apparatus by the user as in amended claim 13.

Additionally, as discussed above in conjunction with claim 1, because modifying Rosenberg as proposed by the Examiner to perform actions such as transmitting music data in response to selection of music data by a user alters a principle operation of Rosenberg, and because Rosenberg teaches away from the combination of Rosenberg and Yamaura as contemplated by the Examiner, the proposed combination of Rosenberg and Yamaura is improper.

For at least these reasons, the proposed combinations of Rosenberg, Yamarua, and Dodrill do not render independent claim 13, or any claim that depends on claim 13, unpatentable.

IV. The Proposed Combinations Do Not Render Claim 17 Unpatentable

Independent claim 17 recites a server data transmitting/receiving unit operable to transmit music data selected at a client apparatus to the client apparatus in response to selection of the music data at the client apparatus. As discussed above in conjunction with claim 1, because modifying Rosenberg as proposed by the Examiner to perform actions such as transmitting music data in response to selection of music data by a user alters a principle operation of Rosenberg, and because Rosenberg teaches away from the combination of Rosenberg and Yamaura as contemplated by the Examiner, the proposed combination of Rosenberg and Yamaura is improper. For at least this reason, the proposed combinations of Rosenberg, Yamarua, and Dodrill do not render independent claim 17, or any claim that depends on claim 17, unpatentable.

V. Rosenberg Does Not Anticipate Independent Claim 22

Independent claim 22 recites selecting a decoder used to reproduce content on a client apparatus based on a desired medium. While Rosenberg may state that the Rosenberg system may include a decoder, Rosenberg fails to make any mention of selecting a decoder, or selecting a decoder based on a medium as recited in claim 22. In the Office Action, the Examiner again asserts that Figs. 2, 22, 23, and 26; Col. 5, lines 9-41; Col. 10, lines 1-18; Col. 25, lines 50-67; and Col. 26, lines 23-43 of Rosenberg teach selecting a decoder used to reproduce content on a client apparatus based on a desired medium. Applicants disagree and maintain that none of the portions of Rosenberg cited by the Examiner teach the action of selecting a decoder, let alone selecting a decoder based on a desired medium.

In the Office Action the Examiner asserts, "Rosenberg Fig. 2 shows DECODER 222 receiving audio data via 210 and based on either outputting to AMP 224 or sending for storage device (media type) 214 or 276 ((e.g., floppy disk drive or CD ROM drive)(see (decoder 222, fig. 2 and col. 10, lines 1-18 and fig. 26). Hence Rosenberg
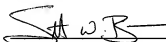
clearly teaches the limitation as argued." (See Office Action dated Oct. 10, 2008, page 4). Applicants note that audio data is not sent from the Decoder to the storage device in Fig. 2 of Rosenberg as asserted by the Examiner.

Because Rosenberg fails to teach selecting a decoder used to reproduce content on a client apparatus based on a desired medium, Rosenberg necessarily does not anticipate independent claim 22, or any claim that depends on claim 22.

VI.   Conclusion

In view of the foregoing remarks, Applicants submit that the pending claims are in condition for allowance. If there are any questions concerning this Response, the Examiner is asked to phone the undersigned attorney at (312) 321-4200.

Respectfully submitted,

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